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EXAMINER

LEUNG, JENNIFER A

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## CONTINUATION SHEET

Item 11.

Applicant's request for reconsideration has been considered, but it does not place the application in condition for allowance, for the same reasons set forth in the final Office Action.

In summary, Applicant (page 4, last paragraph, to page 6, first paragraph) argues that the combination of Bausche et al. and Kaga fails to disclose the claimed apparatus, since the claimed apparatus manufactures developer materials, whereas the apparatus of Bausche et al. manufactures biologically active or pharmaceutical materials. In particular, Applicant argues,

“[t]here is no suggestion in Bausche, e.g., that the apparatus described therein could be modified and operated to make developers comprising a resin with dispersed coloring pigments. Manifestly, Bausche *fails* to teach or suggest, e.g., that the apparatus comprises a “developer material carrier containing developer material comprising a resin and a pigment,” as claimed herein.” (at the paragraph bridging pages 4 and 5).

Similarly, Applicant argues that Kaga fails to teach or suggest a developer material carrier containing developer material comprising a resin and a pigment.

Applicant's argument, however, is not found persuasive.

According to MPEP section 2114, apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Furthermore, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural

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limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

According to MPEP section 2115, expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, the inclusion of a material or article worked upon by a structure being claimed does not impart patentability to an apparatus claim. *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935).

Bausche et al. and Kaga may disclose the processing of solid materials other than developer materials. However, because the modified apparatus of Bausche et al. comprises all of the structural limitations of the claim (e.g., a reactor, a jet mechanism capable of forming particles, a mechanism connecting the reactor to the jet mechanism, an open chamber, a material carrier, and a stirring mechanism), the modified apparatus of Bausche et al. meets the claim. Please note that the recitations with respect to the specific materials being worked upon by the apparatus (e.g., the initial developer material comprising a resin and a pigment within the carrier; the supercritical or subcritical fluid for dissolving the developer material; the formed particles of developer having dispersed coloring agent) do not impart further patentability to the apparatus claim. The Examiner further asserts that the modified apparatus of Bausch et al. would be structurally capable of processing the claimed developer material into particles of developer having dispersed coloring agent, since the modified apparatus comprises all of the necessary structural components for enabling said processing.

Applicant (at page 6, third paragraph) further argues that one having ordinary skill in the art would not have combined the teachings of Kaga with Bausch et al., since the Kaga references was published in 1986 and the Bausche et al. reference was published much later, in 1998.

However, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Regarding Applicant's arguments (page 6, second to last paragraph, to page 7, fifth paragraph) pertaining to the secondary reference of Inoue, the reference was merely relied upon for its teaching that an increase in shearing force is achieved when a material carrier is rotated in reverse relative to the rotation direction of a stirring mechanism disposed therein. One having ordinary skill in the art would have recognized that an increase in shearing force predictably increases the dissolution of a solid material in a fluid.

#### CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. LEUNG whose telephone number is (571) 272-1449. The examiner can normally be reached on 9:30 am - 5:30 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer A. Leung/  
Primary Examiner, Art Unit 1797